

Amendment filed January 7, 2005. Applicants respectfully request clarification of the status of these claims for the record.

No amendments are made in this Response.

## **II. Rejection under § 103(a)**

The Examiner rejects claims 1 and 7-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,019,962 to Rabe et al. ("*Rabe*"). Final Office Action, page 2. Specifically, the Examiner alleges that *Rabe* discloses cosmetic products with improved lubricity (citing the title and col. 2, line 25). *Id.* The Examiner further alleges that "WP-660 is specified (column 8 line 23)" and an "[e]ye shadow is disclosed (column 19 example 6)." *Id.* Therefore, the Examiner concludes that it would have been obvious to use the product disclosed in *Rabe* "to achieve the beneficial effect of improved lubricity" and that "it would be [] obvious[ly] expedient, even to the layman, to use the Rabe et al.[.] eye shadow to disguise the appearance of dark circles around the eyes, thereby reducing the appearance of dark circles surrounding the eyes." *Id.* Applicants respectfully disagree for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references to arrive at the presently claimed invention. Third, there must be a reasonable expectation of success. M.P.E.P. § 2143. "Both the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the

applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

The Examiner has failed to point to any evidence of a suggestion or motivation to modify *Rabe* to arrive at the presently claimed invention. The Examiner only arrives at the claimed invention using hindsight.

*Rabe* discloses that, among "[o]ptional [i]ngredients," solid formers, such as "a. [s]olid [p]olyol [p]olyesters," "b. [w]axes," and "c. [s]olid [o]ils." Col. 4, line 61 - col. 9, line 27. For each types of the solid formers, *Rabe* further discloses laundry lists of examples. "WP 660" is disclosed in *Rabe* as an optional ingredient, i.e., an example of the synthetic waxes, among a laundry list of many other kinds of the solid formers. Col. 8, lines 20-24. Therefore, contrary to the Examiner's allegation, WP660 is not used to achieve *Rabe*'s beneficial effect of improved lubricity, but merely serves as an optional solid former. Indeed, Example 6 disclosed in *Rabe*, which the Examiner relies on for the disclosure of an eye shadow, does not contain "WP 660." Col. 19, lines 1-25.

Accordingly, the Examiner has failed to point to any evidence of a suggestion, motivation, or guidance that would have led one of ordinary skill in the art to pick and choose "WP 660" for use in an eye shadow over other optional ingredients disclosed in *Rabe*.

Further, besides the eye shadow, *Rabe* equally discloses other types of cosmetic products using its composition, including lip cosmetic products in Examples 1 and 4, a liquid foundation in Example 2, a mascara in Example 3, and a liquid eye liner in Example 5. Col. 16, line 20 - col. 18, line 67. In addition, *Rabe* emphasizes the attributes of long-wearing cosmetic products, such as lip products, are enhanced by its

compositions. Col. 2, lines 19-64. Therefore, nowhere does *Rabe* suggest or motivate one of ordinary skill to choose “WP 660” for use in an eye shadow and to apply its composition “to skin with dark circles surrounding the eyes” “to reduce the appearance of the dark circles” as recited in, for example, the present claim 1.

The Examiner has also failed to establish that *Rabe* teaches or suggests each and every limitation of the rejected claims. Specifically, the Examiner has failed to establish that *Rabe* teaches or suggests a “method of reducing the appearance of dark circles around eyes comprising applying to skin with dark circles surrounding the eyes a composition comprising at least one copolymer” as recited in, for example, claim 1 of the present invention.

*Rabe* discloses “compositions and methods for using said compositions with cosmetic products” “to improve the performance of long-wearing cosmetic products.” Col. 1, lines 14-16; col. 1, line 66 - col. 2, line 3. The cosmetic products disclosed in *Rabe* have “a solubility parameter less than or equal to  $8.5 \text{ (calories/cm}^3)^{1/2}$ .” Col. 1, line 67 - col. 2, line 3; col. 2, line 65 - col. 3, line 1. The inventive compositions disclosed in *Rabe* “comprise oils having a C log P value greater than or equal to 13.” Col. 2, lines 3-5. *Rabe* further discloses that the “compositions and methods for using such compositions enable the user to significantly enhance the attributes of long-wearing cosmetic products without compromising their primary advantage” (col. 1, lines 16-19), wherein the attributes, in the case of lip products, “include gloss, shine and lubricity.” Col. 2, lines 19-25.

Nowhere does *Rabe* teach or suggest applying its composition “to skin with dark circles surrounding the eyes” “to reduce the appearance of the dark circles” as recited

in, for example, the present claim 1. The Examiner merely concludes without explanation that "it would be an obvious expedient, even to the layman, to use the Rabe et al eye shadow to disguise the appearance of dark circles around the eyes." Final Office Action, page 2. However, eye shadow is not used to reduce the appearance of the dark circles around eyes. Therefore, the Examiner has failed to establish that *Rabe* teaches or suggests each and every limitation of the rejected claims.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request that this rejection be withdrawn.

### III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application, and the timely allowance of the pending claims.

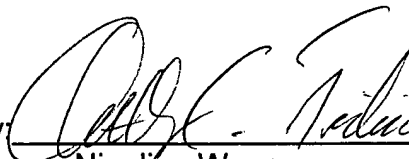
If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned Applicants' representative at (202) 408-4218.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Date: August 18, 2005

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